



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,883	04/24/2001	Masao Mougi	16869P025800	6133

20350 7590 09/13/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

CANGIALOSI, SALVATORE A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,883

Applicant(s)

MOUGI ET AL.

Examiner

Salvatore Cangialosi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3621

1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 18-32 are rejected under 35 U.S.C. § 103 as being unpatentable over Ginter et al (5892900) in view of Horstmann (6009401).

Regarding claim 18, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue

Art Unit: 3621

a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15,Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use. Regarding claim 19, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key

Art Unit: 3621

for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations a Regarding claim 20, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of

Art Unit: 3621

user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15,Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations. Regarding the program limitations of claim 21, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by

Art Unit: 3621

merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations. Regarding the program limitations of claim 22, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data including storage which is the functional equivalents of the claim limitations. Regarding claim 23, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting

Art Unit: 3621

to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15,Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use. Regarding claim 24, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal

Art Unit: 3621

information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15,Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use. Regarding claim 25, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines

Art Unit: 3621

20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15,Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use. Regarding claim 26, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be

Art Unit: 3621

used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use. Regarding claim 27, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing

Art Unit: 3621

certain confidential user information from being written to data structures that will be reported to third parties)) disclose method for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15,Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use. Regarding claim 28, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data

Art Unit: 3621

structures that will be reported to third parties)) disclose method for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15,Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use. Regarding claim 29, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose

Art Unit: 3621

method for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use.

Regarding the license limitations of claim 30, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue

Art Unit: 3621

a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data including license which is the functional equivalents of the claim limitations. Regarding claim 31, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose method for a server to issue a license to a client upon verification and issuing a license key (including trial use) for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server (See Fig. 1) are functionally equivalent to a license issuing computer. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) show license by merchant computer. It would have been obvious to the person having ordinary skill in this art to

Art Unit: 3621

provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use. Regarding the license limitations of claim 32, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data including license which is the functional equivalents of the claim limitations.

Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as

Serial Number: 09/841,883

16

Art Unit: 3621

well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at **(571) 272-6712**.

Any response to this action should be mailed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to (703)872-9306

Hand delivered responses should be brought to

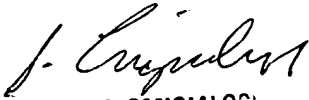
United States Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Serial Number: 09/841,883

17

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222